IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application		
Inventor	:	Yang Peng
Application No.	:	10/582,568
Filed	:	June 12, 2006
For	:	***METHOD OF PLAYING CONTENT AND DEVICE FOR PLAYING CONTENT***

APPEAL BRIEF

On Appeal from Group Art Unit 2444

Michael E. Belk

/Carl A. Giordano/

Date: December 6, 2011

By: Carl A. Giordano
Attorney for Appellant
Registration No. 41,780

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, U.S. Philips Corporation, and not the party named in the above caption.

II. RELATED APPEALS AND INTERFERENCES

With regard to identifying by number and filing date all other appeals or interferences known to Appellant that will directly effect or be directly affected by or have a bearing on the Board's decision in this matter, Appellant is not aware of any such appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-18 have been presented for examination. All of these claims are pending, stand finally rejected, and form the subject matter of the present appeal.

IV. STATUS OF AMENDMENTS

In response to the Final Office Action, having a mailing date of July 8, 2011, Appellant timely submitted arguments to overcome the reasons for rejecting the claims. No amendments were made to the claims. In reply to the Appellant's Response to the Final Office Action, an Advisory Action, having a mailing date of September 22, 2011, was entered into the record. The Advisory Action provided further rationale for maintaining the rejection of the claims in reply to the Appellant's arguments. The Advisory Action further stated that for purposes of Appeal the amendments to the claims would be entered. A copy of the claims, as currently of record, is presented herein.

A Notice of Appeal was timely filed in response to the Advisory Action and this Appeal Brief is being timely filed, with appropriate fee, within the period of response from the date of the Notice of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is expressed primarily in independent claims 1, 4, 7, 10, 13 and 16. Claims 1, 4, and 7 represent methods for executing the processing claimed. Claims 10, 13 and 16 represent devices for executing the processing claimed.

Independent claim 1 recites a method, operable in a processing system (element 20), for playing a content available for downloading, comprising the steps:

reading a pre-stored content providing additional-information regarding a content of said content available for downloading (page 5, lines 20-21; Figure 4, S400; Figure 5, S500), the pre-stored content including at least a quality menu of the content available for downloading (S510) wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading ((page 7, lines 2-10, Figure 5; S520), said quality options being independent of rendering capabilities of said processing system;

detecting an available bandwidth (page 5, line 29-page 6, line 3; Figure 5, S520);

sending a request for downloading the content available for downloading according to the additional information regarding the content available for downloading (page 6, lines 14-16; Figure 5, S540), wherein the request includes information of the detected available bandwidth;

selecting a quality for downloading the content available for downloading from the quality menu associated with the content available for downloading (page 7, lines 2-10), the quality selected being in conformance with the detected available bandwidth;

receiving (page 6, lines 16-17) the content available for downloading according to the selected quality associated with the detected bandwidth (Figure 5, S550);

playing (page 7, lines 15-17) the content available for downloading combined with the pre-stored content synchronously (Figure 5, S560); and

monitoring (page 5, line 29-page 6, line 3) the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

Independent claim 4 recites a method, operable in a processing system (element 20, 30), for playing a content available for downloading, comprising the steps:

reading a pre-stored content providing additional-information regarding a content of said content available for downloading (page 5, lines 20-21), the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading (page 7, lines 2-10), said quality options being independent of rendering capabilities of said processing system;

detecting an available bandwidth (page 5, line 29-page 6, line 3);

sending a request for downloading the content available for downloading according to the additional information regarding the content available for downloading, wherein the request includes information of the detected available bandwidth (page 6, lines 14-16);

selecting a quality for downloading the content available for downloading from the quality menu associated with the content available for downloading (page 8, lines 23-25), the quality selected being in conformance with the detected available bandwidth;

receiving the content available for downloading according to the selected quality associated with the detected bandwidth (page 7, lines 2-10);

playing the content available for downloading combined with the pre-stored content synchronously (page 7, lines 15-17); and

monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously (page 5, line 29-page 6, line 3) .

Independent claim 7 recites a method for playing a content available for downloading, comprising the steps:

reading a pre-stored content which include information regarding a content of the content available for downloading (page 5, lines 20-21), the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with

different bandwidth related rendering qualities associated with the content available for downloading (page 7, lines 2-10), said quality options being independent of rendering capabilities of a system for playing the content;

detecting an available bandwidth (page 8, lines 23-25);

selecting, from the quality menu, a relevant quality of the content available for downloading according to the detected bandwidth information and the information regarding the content of the content available for downloading;

sending a request for downloading the content available for downloading according to the information regarding the content of the downloaded content (page 6, lines 14-16), wherein the request includes the relevant quality;

receiving the content available for downloading according to the relevant quality (page 7, lines 15-17);

playing the content available for downloading combined with the pre-stored content of the content available for downloading synchronously (page 7, lines 15-17); and

monitoring the available bandwidth to select a quality from the quality menu for playing ~~of~~ the combined content available for downloading and the pre-stored content synchronously (line 29-page 6, line 3).

Independent claim 10 recites a device (element 20, 30) for playing a content available for downloading, comprising:

a reading means (element 21, page 5, lines 20-21) for reading a pre-stored content which include information regarding a content of the content available for

downloading, the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading (page 7, lines 2-10), said quality options being independent of rendering capabilities of the device;

a detecting means for detecting an available bandwidth (page 5, line 29-page 6, line 3, element 26);

a sending means (element 27, page 6, lines 14-16) for sending a request for downloading the content available for downloading according to the information contained within the pre-stored content, wherein the request includes the information of the bandwidth;

a receiving means (element 28, page 6, lines 16-17) for receiving the content available for downloading according to a quality selected based on the detected bandwidth;

a playing means (element 24, page 7, lines 15-17) for playing the content available for downloading combined with the pre-stored content; and

a monitoring means (element 26) for monitoring the available bandwidth to select a quality from the quality menu for playing ~~of~~ the combined content available for downloading and the pre-stored content synchronously.

Independent claim 13 recites a device (element 20, 30) for playing a content available for downloading, comprising:

a reading means (element 21, page 5, lines 20-21) for reading a pre-stored content which include information regarding a content of the content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading, wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading (page 7, lines 2-10), said quality options being independent of rendering capabilities of the device;

a detecting means for detecting available bandwidth (page 5, line 29-page 6, line 3, element 26);

a selecting means (element 31, page 7, lines 2-10) for selecting relevant quality of the content available for downloading according to the detected bandwidth information and the information regarding the content available for downloading;

a sending means (element 27, page 6, lines 14-16) for sending a request for downloading the content available for downloading according to the information relevant to the downloaded content, wherein the request includes the relevant quality;

a receiving means (element 28, page 6, lines 16-17) for receiving the content available for downloading according to the relevant quality;

a playing means (element 24, page 7, lines 15-17) for playing the content available for downloading combined with the pre-stored content; and

a monitoring means (element 26) for monitoring the available bandwidth to select a from the quality menu for playing ~~of~~ the combined content available for downloading and the pre-stored content synchronously.

Independent claim 16 recites a device (element 20, 30) for playing a content available for downloading, comprising:

a reading means (element 21, page 5, lines 20-21) for reading a pre-stored content which include information regarding a content of the content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading (page 7, lines 4-10), wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with ~~for~~ the content available for downloading, said quality options being independent of rendering capabilities of the device;

a detecting means for detecting an available bandwidth (page 5, line 29-page 6, line 3, element 26);

a selecting means (page 8, lines 23-24, element 31) for selecting relevant quality of the content available for downloading according to the detected bandwidth information and the information regarding the content of the content available for downloading;

a sending means (element 27, page 6, lines 14-16) for sending a request for downloading the content available for downloading according to the information relevant to the content available for downloading, wherein the request includes the relevant quality;

a receiving means (element 28, page 6, lines 16-17) for receiving the content available for downloading according to the relevant quality;

a playing means (element 24, page 7, lines 15-17) for playing the content available for downloading combined with the pre-stored content; and

a monitoring means (element 26) for monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

The remaining claims, which depend from the independent claims, provide further aspects of the invention claimed.

VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The issue in the present matter is whether:

(1) Claims 1-18 are unpatentable under 35 USC 103(a) over Salmonsen (USP no. 7, 209, 874) in view of Sato (USPPA 2003/0041123) further in view of Pak (USPPA 2004/0267790) and further in view of Silen (USPPA 2002/0116518).

VII. ARGUMENT

I. Rejection of claims 1-18 under 35 USC §103

The rejection of claims 1-18 as being unpatentable under 35 USC §103(a) in view of Salmonsen, Sato, Pak and Silen is in error as the combination of t the cited references fails to disclose a material element recited in the independent claims and, consequentially, the claims dependent therefrom.

Summary of the Rejection of the Claims

In supporting the rejection of claim 1, for example, which is typical of the remaining independent claims, the FInal Office Action refers to Salmonsen for disclosing a connection manager supporting a content transfer subsystem and a format decoder subsystem that controls connections associated with a particular device including preparation to receive an incoming transfer, flow control and support multiple simultaneous renderers. Salmonsen discloses a method for playing content comprising the steps of playing the content available for downloading combined with the pre-stored content (col. 24, lines 35-40), and synchronous playing of the content to be downloaded and the pre-stored content (col. 26, lines 1-10). The Final Office action acknowledges that Salmonsen does not disclose the elements of:

reading a pre-stored content providing additional information regarding a content of said content available for downloading,

detecting available bandwidth,

sending a request for downloading the content available for downloading according to the additional information regarding the content available for downloading, wherein the request includes the information of the bandwidth,

receiving the content available for downloading according with the detected bandwidth; and

monitoring the available bandwidth to adjust a quality of the combined content available for downloading and the pre-stored content. (see FOA, page 8).

The Final Office Action refers to Sato for disclosing the element of reading a pre-stored content providing additional information regarding a content of said content available for downloading (para. 0046-0047). (FOA page 9).

The Final Office Action refers to Pak for disclosing the element of sending a request for downloading the content available for downloading wherein the request includes the information of the bandwidth and receiving the content available for download according the thee4 detected bandwidth (para. 0039). (FOA, page 9).

The Final Office action refers to Silen for disclosing the element of detecting available bandwidth (para. 19-23) and downloading the requested content according to the bandwidth (para. 26). In addition, Silen discloses monitoring the available bandwidth to adjust a quality of the combined content available for downloading and the pre-stored content (para. 33). (FOA, page 9).

The Final Office action assets that Salmonsen, Sato, Pak and Silen are analogous art because they present concepts and practices regarding

presentation of media over a network. At the time ... it would have been obvious to combine Sato into Salmonsen. The motivation of said combination would have been so that there is no need for the user to enter the address information manually (Sato-para. 0016). Similarly, ... it would have been obvious to combine Pak into Salmonsen-Sato. The motivation ... would have been to automatically send the client device environment information and avoid having the user make mistakes in manipulating the household appliances to effect a download (Pak-para. 0009). Similarly ... it would have been obvious to combine Silen into Salmonsen-Sato-Pak. The motivation ... would have been to enable adjusting a presentation frame size based upon detected bandwidth in order to present the most suitable quality of the download content. (FOA, pages 9-10).

The Final Office Action further states "[t]he Examiner notes that Sato disclosed pre-stored content providing the URL address of the content source Sato did not disclose *pre-store content including at least a quality menu of the content available for downloading, wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the downloaded content."* (emphasis in the original).

Pak, para. 0039, disclosed adjusting the downloaded process based on the user rendering device capabilities (para. 0034) such as hardware specifications, resolution, display sized and number of channels. Furthermore Pak figure 7 disclosed a content database containing different rending options for each particular content requested by the user. The Examiner notes that the combination of resolution, display size and number of channels represents the

equivalent of a rendering quality and the multiple rendering options are the equivalent to a quality menu. The Examiner notes that ... it was well-known to provide rendering options on a DVD and that storing additional information regarding the content on a DVD is also well-known. The Examiner notes that the limitations indication "*quality options being independent of rendering capabilities of said processing system"* is a negative limitation that does not further limit the claims. (emphasis in original). Upon inspection of Applicant [sic] Specifications Page 1 lines 2-30, the Examiner interprets said "quality options being independent of rendering capabilities of said processing system" as a selection of available type of network connections and their corresponding bandwidth attributes. Pak Figure 4, para. 0035, 0039 discloses wherein the client environment is referring to the network transmission velocity of a network data transmission channel available for downloading. The said network data channel transmission velocity is an attribute that is not tied to any particular device and is indicative of the type of network connection and the features of the network. Pak para. 0051 discloses selecting one quality of content based on the type of network connection. The Examiner notes that while Pak disclosed consideration of the 1) device rendering capabilities in addition to the 2) network data channel transmission velocity, ***it would have been obvious ... to use only one of the client attributes.*** (emphasis added). At the time of the invention ... it would have been obvious to include the available network options by Pak such as network data channel transmission velocity with pre-stored information disclosed by Sato for the user rendering device to match the rendering options before

making the download request of content. This would [be] an improvement of Pak because in Pak the client environment database does not account for network conditions after the initial selection of network data channel transmission velocity. Silen provides the disclosure and motivation for accounting for variable network conditions when downloading content over the network.

Thus, Salmonsen-Sato-Pak-Silen disclosed (claim 1) pre-stored content including at least a quality menu of the content available for downloading, wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading, said quality options being independent of rendering capabilities of said processing system.

In addition, the Final Office Action provides further rationale for maintaining the rejection of the claims on pages 3-6, which essentially recite the same reasons for maintaining the rejection of the claims.

In reply to the rejection of the claims, Appellant argued that with regard to the assertion that it would be obvious to amend Pak to use only the network elements within the quality menu, Applicant would note that in addressing obviousness determination under 35 USC 103, the 'Supreme Court in *KSR International Co. v. Teleflex Inc*., (citation omitted) reaffirmed many of its precedents relating to obviousness including its holding in Graham v. John Deere Col, (citation omitted). In *KSR*, the Court also reaffirmed that "a patent composed of several elements is not .... obvious merely by demonstrating that each of its elements was, independently, known in the prior art." In this regard,

the KSR court stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the ... field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."

Furthermore, the Court in *KSR* did not diminish the requirement for objective evidence of obviousness ("[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.").

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention. i.e., something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination. *Uniroyal Inc. v. Rudlkin-Wiley Corp* (citation omitted).

As characterized ... Pak teaches that download considers the rendering capability of the equipment and, thus, the files illustrated by Pak include information regarding the capabilities of the rendering equipment.

For example, Pak teaches that "information related to the hardware specification of the client includes information related to a display, an audio player, language codes and the like. The information related to the display includes resolution, physical size, etc. (see para. 0034). In addition, Pak teaches

that [i]n operation the client request the contents service server to download predetermined contents and transmits the environment information stored in the client environment information storage to the contents service server. ***The environment information includes the information related to the hardware specification and the information related to the features of the network***. (see para. 0040). (emphasis in the original). In addition Pak teaches "[t]he contents service server selects a type of contents from a plurality of types of contents ... based on the environment information suitable for the environment of the client." (see para. 0040).

Thus, Pak explicitly teaches that the selection of a download is based at least on being suitable for the client environment (i.e., the hardware specifications of the rendering equipment). See also para. 0051, 0052 wherein based on the physical rendering characteristics one velocity of data transmission is selected over another (see page 4, lines 1-5).

The Office Action asserts that it would be obvious to only use the network criteria of Pak in determining quality that may be stored in the quality menu. See claim 2, "[t]he contents service server ... wherein the information related to the features ... comprises: information related to the hardware specification of the client ..."

However, ***there is no objective teaching provided by Pak fo***r using only the network bandwidth as Pak specifically teaches using the hardware specification and is attempting to provide a selection feature of using ***"information related to the hardware specification***."

Thus, contrary to the assertions made in the Office Action regarding modifying Pak to use only a portion of the data disclosed by Pak, Pak provides no objective reason that would provide motivation to remove the hardware specification selection feature, as removing this selection feature removes a material element of Pak.

Hence, the use of only the network characteristics is contrary to the teachings of Pak.

In addition, the Office Action refers to Salmonsen for teaching the element of "for playing the combined content available for downloading and the pre-stored content synchronously."

A review of the referred-to section of Salmonsen (col. 26, lines 1-13) reveals that Salmonsen teaches a system that allows for controlling characteristics of different dynamic instances that "enables functionality such as picture-in-picture."

That is, Salmonsen teaches a system wherein two different images or instances may be played at the same time when a PIP function is used to present or display two images or instances.

However, the simultaneous presentation (according to a PIP function) is not comparable to a "synchronous" presentation, as is recited in the claims.

While Salmonsen discloses presentations may be simultaneous (at the same time), there is no disclosure by Salmonsen that the presentations are "in synchronization" with other.

Hence, even if it could be said that the PIP function of Salmonsen provides information regarding the same content in both screens, there is no disclosure by Salmonsen that the playing of "the combined content available for downloading and the pre-stored content *synchronously*."

That is, the claims recite an element that is more specific then the mere simultaneous presentation or display of two images or instances. While the two presentations of Salmonsen may be played at the same time there is no teaching that there is a synchronization between the two content being played. (i.e., "combined content available for downloading and the pre-stored content synchronously.").

In reply to the Appellant's arguments, the Advisory Action assets that the request for reconsideration was considered but does not place the application in condition for allowance because:

The Applicant presents the following argument(s)

"… The element of 'quality options being independent of rendering capabilities of said processing system' does not clearly teach what is not included in the quality menu, hence, provides significant difference to distinguish the invention claimed from the references cited…"

The Examiner disagrees; Pak Figure 4, para 0035, 0039 disclosed wherein the client environment is referring to the network transmission velocity of a network data transmission channel available for downloading. The said network data channel transmission velocity is an attribute that is not tied to any particular

device and is indicative of the type of network connection and the features of the network …"

The Applicant presents the following argument:

"… there is no objective teaching provided by Pak of using only the network bandwidth as Pak specifically teaches using the hardware specification and is attempting to provide a selection feature of using 'information related to the hardware.' … Thus, … there is no objective reason that would provide motivation to remove the hardware specification selection feature, as removing this selection feature removes a material element of Pak. Hence, the use of only the network characteristics is contrary to the teachings of Pak.

The Examiner disagrees;

The Examiner notes that while Pak disclosed consideration of the 1) device rendering capabilities in addition to the 2) network data channel transmission velocity, it would have been obvious … to use only one of the client environment attributes.

While the Examiner generally agrees that t*he hardware specification selection feature is a material element and is a desirable feature in Pak* the Examiner does not agree that a selection feature using *'information related to the hardware specification*' is disclosed as a required and indispensible step of Pak. (emphasis in the original). Given that Pak does not teach a selection feature using 'information related to the hardware specification' as a required and indispensable step, it would have been obvious … to omit said selection when the particular element or function adjustment is not desired, in order to avoid

making the quality menu selection process more complicated than necessary. (emphasis in the original).

The Applicant presents the following argument:

While Salmonsen discloses presentation may be simultaneous, there is no disclosure by Salmonsen that there presentations are "in synchronization" with [each] other ... even if it could be said that the PIP function of Salmonsen provides information regarding the same content in both screens, there is no disclosure by Salmonsen that the playing of the "combined content available for downloading and the pre-stored content synchronously."

The Examiner disagrees:

Salmonsen (Figure 11, col. 26, lines 1-10)disclosed a connection manager 1018 supports the content transfer subsystem 1-12 and the format decoder subsystem ... Salmonsen disclosed (re: claim 1) combining content available for downloading and the pre-stored content (Salmonsen-Col. 24, liens 35-45). Thus Salmonsen-Sato-Pak-Silen disclose synchronous playing of the content to be downloaded and the pre-stored content (Salmonsen-col. 26, lines 1-10, connection manager 1018 supports multiple simultaneous renders, such that the DVD content is played with the downloaded content).

Difference between the Claimed Invention Recited in the Independent Claims and the Cited References

The instant invention, as recited in claim 1, for example, recites

1. (Previously presented) A method, operable in a processing system, for playing a content available for downloading, comprising the steps:

reading a pre-stored content providing additional-information regarding a content of said content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading, said quality options being independent of rendering capabilities of said processing system;

detecting an available bandwidth;

sending a request for downloading the content available for downloading according to the additional information regarding the content available for downloading, wherein the request includes information of the detected available bandwidth;

selecting a quality for downloading the content available for downloading from the quality menu associated with the content available for downloading, the quality selected being in conformance with the detected available bandwidth;

receiving the content available for downloading according to the selected quality associated with the detected bandwidth;

playing the content available for downloading combined with the pre-stored content synchronously; and

monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

In response to the Office's rejection of the claims represented in the Final Office action and reply presented in the Advisory action, Appellant submits that with regard to Salmonsen teaching the elements of "playing the combined content available for downloading and the pre-stored content synchronously." Salmonsen teaches in col. 24, lines 30-45 "[f]or example, the emulator 800 can control a transaction to allow simultaneous rendering of content from the source device and an emulated remote device. One specific capability is a picture-in-picture display of source content and remote content. Another specific capability

is enhanced web-enable DVD that extents capabilities to combine content from a DVD with special network-accessed applications."

Thus, Salmonsen, at best, may teach that a web-enable DVD may provide additional information that may be combined with the content from the DVD. However, there is no teaching that the additional information is played in synchronization with the DVD information. Rather, according to Salmonsen the combined content may present the information in a PIP format, simultaneously (see col. 26, lines 1-10).

With regard to the Office's assertion that because Pak does not disclose a selection feature using 'information related to the hardware specification' as a required and indispensable step, that it would be obvious to remove the hardware specification criteria.

However, Appellant submits that Pak teaches that content may be stored on a server in a form that is related to a minimum data transmission rate (see Figure 1). When a user desires to view content (e.g., content #1), a user may select a content based on the data transmission velocity. (see para. 0006). However, Pak further notes that the user is more likely to be unfamiliar with the manipulations of the household appliances having added personal devices for the user interface. Thus, the user is inconvenienced because the user is required to have knowledge of the network environment of the household appliances and the specifications of various kinds of hardware, such as a display device, an audio player, etc., in order to download specific contents. Moreover,

the user is more likely to make a mistake during the manipulation of the household appliances in an effort to download the specific contents. (see para. 0009). Thus, Pak teaches "[a]ccording to an aspect of the present invention, a client to allow convenient download of a t***ype of contents suitable for the client's hardware and the environment of a network,*** and a method to download contents using the client is provided (see para. 0011). (emphasis added). With reference to Figure 4 (see para. 0033) Pak illustrates an example of the environment information stored in the client environment information storage 33. … the environment information includes information related to hardware specification of the client and information related to features of a network. With reference to Figure 7, Pak further teaches an example of information related to the features of the plurality of the types of contents stored in the content data, wherein the different types of content include a plurality of types of content with details suitable for the environment of the client, such as the hardware specification of the client and/or the information related to the features of the network. (see para. 0044).

Thus, Pak explicitly teaches a system that incorporates the hardware specifications in order to provide convenience to the user (and to prevent user mistakes) in the selection of content.

Hence, ***Pak teaches away*** from having a selection criteria in order to limit the user's ability to select content independent of the rendering characteristics of the hardware as the content selection are predetermined based, in part, on the hardware specifications.

Thus, the Examiner's position that because "Pak does not teach a selection feature, then it would be obvious to omit said selection ... is not desired, in order to avoid making the quality menu selection more complicated than necessary," is totally contrary to the teachings of Pak, as Pak specifically teaches the hardware specification is utilized so as to provide a convenience to the user and to avoid mistakes.

Hence, Appellant submits that because Pak specifically teaches using the hardware specification for the convenience of the user, there is no objective teaching found in Pak to use only the network bandwidth.

Even if it could be said that Figure 1 of Pak teaches a bandwidth selection (which has not been used as an argument in rejecting the claims), Pak fails to teach that the bandwidth disclosed is associated with the detected bandwidth, recited in the claims.

Rather, Pak teaches that ***a minimum bandwidth is provided in the quality menu, which is preset. Pak fails to provide any teaching regarding "an available bandwidth,"*** as is recited in the claims.

With regard to the Office's assertion that the element "quality options being independent of rendering capabilities of said processing system" does not clearly teach what is not included in the quality menu, Appellant submits that the element of the quality options being independent of rendering capabilities of said processing system clearly teaches what is not included in the quality menu. One

skilled in the art would understand that the rendering capabilities of the processing system would not be incorporated into the quality menu.

Although this recitation of what is not included in the quality menu represents a negative limitation, such negative limitations are acceptable in describing what is considered within the scope of the invention claimed.

"The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation, so long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claims comply with the requirements of 35 USC112, second paragraph." MPEP 2173.05(i).

Thus, although Pak teaches that there is a network element in the selection of the client environment, Pak explicitly teaches that the client environment includes the hardware specification and, hence, there is no need for a selection option that removes the hardware specification from the requirements of Pak.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met;

> 1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
>
> 2. there must be a reasonable expectation of success; and
>
> 3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Appellant's disclosure. In re

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In addressing obviousness determination under 35 USC §103, the Supreme Court in *KSR International v. Teleflex Inc.* (citation omitted) addressed the standard for obviousness that had been imposed in decisions rendered by the CAFC in that there must be some teaching, suggestion or motivation (TSM) to combine the known elements in the same manner set forth in the claims and found that the TSM to combine provides a "helpful hint" in determining whether claimed subject matter is obvious. The Court however stated that the application of the TSM (teaching, suggestion, motivation) test is not to be applied in a rigid manner and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, contrary to the assertions made in maintaining the rejection of the claims, Appellant submits that the combination of the cited references fails to disclose a material element recited in the claims and, hence, the combination of the cited references fails to render obvious the subject matter recited in the claims.

As shown in the analysis above, Pak fails to provide any motivation to use ***an available bandwidth*** or ***"quality options independent of rendering capabilities of said processing system;"***

In addition, Appellant submits that Salmonsen fails to provide any teaching regarding "playing the content available for downloading combined with the pre-stored content **synchronously**."

Accordingly, the combination of the cited references fails to disclose a material element recited in the claims. Hence, the independent claims, and the claims dependent therefrom are not rendered unpatentable over the cited references.

In addition, the Manual of Patent Examining Procedure (MPEP) provides further appropriate instruction by which the instant Appeal should be judged. MPEP, § 2143.01 (IV) entitled: "Mere Statement That The Claimed Invention Is Within The Capabilities Of One Of Ordinary Skill In The Art Is Not Sufficient By Itself To Establish *PRIMA FACIE* Obviousness" states:

> A statement that modification of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP §2143.01 (IV), p. 2100-131.

In this case, as the references fail to teach all the elements recited in the claims, and as significant modification of the teachings of the references is

necessary to satisfy the subject matter claimed, Appellant respectfully submits that a *prima facie* case of obviousness has not been made as the Office has failed to show the combination of the cited references discloses, teaches or suggests all the elements recited in the claims.

For at least the this reason also,, Appellant respectfully submits that a case of obviousness has not been set forth.

Additionally, MPEP § 2143.01(V), entitled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose" provides further reason for overturning the rejection of the claims. MPEP § 2143.01(V) states:

> If the propose modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As shown above, Pak explicitly teaches away from using only the minimum bandwidth to download content in order to avoid inconvenience to a user and explicitly teaches incorporating the hardware specification in determining the downloaded content.

Hence, according to Pak, the user need not have any knowledge of the type or characteristics of the rendering but is able to view the content with the appropriated quality.

Thus, the modification suggested by the Office (i.e., to use only the network characteristic) is contrary to the teachings of Pak and, hence, renders Pak

unsuitable for its intended purpose (i.e., provide convenience to the user in the user not having to know characteristics of rendering equipment.).

Appellant respectfully submits that a *prima facie* case of obviousness has not been made as the Office has suggested a modification to Pak be implemented that would render the Pak reference unsuitable for its intended purpose.

Thus, there is no motivation to modify Pak, as suggested by the Office, and, thus, the combination of the cited references fails to recite all the elements recited in the claims.

For at least the above reasons, Appellant respectfully submits that a case of obviousness of the independent claims has not been set forth as the combination of the references fails to disclose all the elements recited in the claims.

With regard to the remaining claims, these claims depend from the independent claims an Appellant respectfully submits that these claims are also not rendered obvious at least for their dependence upon an allowable base claim, without contemplating the merits of the rejection of the dependent claims for reasons held in *In re Fine,* (citation omitted) (if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious).

In view of the above, Appellant submits that the independent claims and the claims dependent therefrom are patently distinguishable and not rendered obvious over the teaching of the cited references.

Appellant respectfully requests that this Honorable Board reverse the rejection of the claims and issue a Notice of Allowance.

VIII. CONCLUSION

In view of the above analysis, it is respectfully submitted that the referenced teachings, whether taken individually or in combination, fail to render obvious the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,

/Carl A. Giordano/

Date: December 8, 2011

By: Carl A. Giordano
Attorney for Appellant
Registration No. 41,780

IX. CLAIMS APPENDIX

1. (Previously presented) A method, operable in a processing system, for playing a content available for downloading, comprising the steps:

reading a pre-stored content providing additional information regarding a content of said content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading, said quality options being independent of rendering capabilities of said processing system;

detecting an available bandwidth;

sending a request for downloading the content available for downloading according to the additional information regarding the content available for downloading, wherein the request includes information of the detected available bandwidth;

selecting a quality for downloading the content available for downloading from the quality menu associated with the content available for downloading, the quality selected being in conformance with the detected available bandwidth;

receiving the content available for downloading according to the selected quality associated with the detected bandwidth;

playing the content available for downloading combined with the pre-stored content synchronously; and

monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

2. (Previously presented)The method according to claim 1, wherein the request includes a URL of a website on which the content available for downloading is stored.

3. (Original)The method according to claim 1, wherein the detecting step is arranged for detecting throughput of effective information transmitted within a specific period.

4. (Previously presented) A method for playing a content available for downloading on a processing system, comprising the steps:

reading a pre-stored content providing additional information regarding a content of said content available for downloading, the additional information including at least a quality menu of the content available for downloading, wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading, said quality options being independent of rendering capabilities of said processing system;

detecting an available bandwidth;

selecting a relevant quality of the content available for downloading according to the detected bandwidth information from the quality menu and the additional information regarding the content available for downloading;

sending a request for downloading the content available for downloading according to the information relevant to the content available for downloading, wherein the request includes the relevant quality;

receiving the content available for downloading according to the relevant quality;

playing the content available for downloading combined with the pre-stored content synchronously; and

monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

5. (Previously presented)The method according to claim 4, wherein the additional information regarding the content available for downloading further includes an ID of an optical disk, and an URL of a website on which the content available for downloading is stored.

6. (Original)The method according to claim 4, wherein the detecting step is arranged for detecting throughput of effective information transmitted within a specific period.

7. (Previously presented) A method for playing a content available for downloading, comprising the steps:

reading a pre-stored content which include information regarding a content of the content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with ~~for~~ the content available for downloading, said quality options being independent of rendering capabilities of a system for playing the content;

detecting an available bandwidth;

selecting, from the quality menu, a relevant quality of the content available for downloading according to the detected bandwidth information and the information regarding the content of the content available for downloading;

sending a request for downloading the content available for downloading according to the information regarding the content of the downloaded content, wherein the request includes the relevant quality;

receiving the content available for downloading according to the relevant quality;

playing the content available for downloading combined with the pre-stored content of the content available for downloading synchronously; and

monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

8. (Previously presented)The method according to claim 7, wherein the information regarding the content of the content available for downloading includes an ID of an optical disk, an URL of a website on which the content available for downloading is stored.

9. (Original)The method according to claim 8, wherein the detecting step is arranged for detecting throughput of effective information transmitted within a specific period.

10. (Previously presented) A device for playing a content available for downloading, comprising:

a reading means for reading a pre-stored content which include information regarding a content of the content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content available for downloading, said quality options being independent of rendering capabilities of the device;

a detecting means for detecting an available bandwidth;

a sending means for sending a request for downloading the content available for downloading according to the information contained within the pre-stored content, wherein the request includes the information of the bandwidth;

a receiving means for receiving the content available for downloading according to a quality selected based on the detected bandwidth;

a playing means for playing the content available for downloading combined with the pre-stored content; and

a monitoring means for monitoring the available bandwidth to select a quality from the quality menu for playing of the combined content available for downloading and the pre-stored content synchronously.

11. (Previously presented) The device according to claim 10, wherein the request includes a URL of a website on which the content available for downloading is stored.

12. (Original) The device according to claim 10, wherein the detecting means are arranged for detecting throughput of effective information transmitted within a specific period.

13. (Previously presented) A device for playing a content available for downloading, comprising:

a reading means for reading a pre-stored content which include information regarding a content of the content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading, wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with the content

available for downloading, said quality options being independent of rendering capabilities of the device;

a detecting means for detecting available bandwidth;

a selecting means for selecting relevant quality of the content available for downloading according to the detected bandwidth information and the information regarding the content available for downloading;

a sending means for sending a request for downloading the content available for downloading according to the information relevant to the downloaded content, wherein the request includes the relevant quality;

a receiving means for receiving the content available for downloading according to the relevant quality;

a playing means for playing the content available for downloading combined with the pre-stored content; and

a monitoring means for monitoring the available bandwidth to select a from the quality menu for playing ~~of~~ the combined content available for downloading and the pre-stored content synchronously.

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14. (Previously presented) The device according to claim 13, wherein the information relevant to the content available for downloading includes an ID of an optical disk, an URL of a website on which the downloaded content is stored and the quality menu.

15. (Original) The device according to claim 13, wherein the detecting means

are arranged for detecting throughput of effective information transmitted within a specific period.

16. (Previously presented) A device for playing a content available for downloading, comprising:

a reading means for reading a pre-stored content which include information regarding a content of the content available for downloading, the pre-stored content including at least a quality menu of the content available for downloading, wherein the quality menu includes a plurality of quality options associated with different bandwidth related rendering qualities associated with ~~for~~ the content available for downloading, said quality options being independent of rendering capabilities of the device;

a detecting means for detecting an available bandwidth;

a selecting means for selecting relevant quality of the content available for downloading according to the detected bandwidth information and the information regarding the content of the content available for downloading;

a sending means for sending a request for downloading the content available for downloading according to the information relevant to the content available for downloading, wherein the request includes the relevant quality;

a receiving means for receiving the content available for downloading according to the relevant quality;

a playing means for playing the content available for downloading combined with the pre-stored content; and

a monitoring means for monitoring the available bandwidth to select a quality from the quality menu for playing the combined content available for downloading and the pre-stored content synchronously.

17. (Previously presented)The device according to claim 16, wherein the information relevant to the content available for downloading includes an ID of an optical disk, an URL of a website on which the downloaded content is stored.

18. (Original) The device according to claim 17, wherein the detecting means are arranged for detecting throughput of effective information transmitted within a specific period.

X. EVIDENCE APPENDIX

Other than those documents submitted in an Information Disclosure Statement provided by the Appellant and the prior art references cited by the Examiner, no further evidence is submitted herein.

XI. RELATED PROCEEDING APPENDIX

No related proceedings are pending and, hence, no information regarding same is available